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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,086	03/29/2001	Himiko Takayama	T-5884	6983

7590

12/06/2004

Chevron Corporation  
Law Department, Patent and Licensing Unit  
P.O. Box 6006  
San Ramon, CA 94583-0806

EXAMINER
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MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/823,086

Applicant(s)

TAKAYAMA ET AL.

Examiner

Ellen M McAvoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004 and 05 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13, 17-28 and 32-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 17-28 and 32-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, 17-28 and 32-36 are still rejected under 35 U.S.C. 103(a) as being unpatentable over Miyagawa et al (5,536,423) or Miyagawa et al (5,561,104).

Applicants' arguments filed 20 September 2004 have been fully considered but they are not persuasive. As previously set forth, the Miyagawa et al ["Miyagawa"] references disclose a hydraulic working oil composition for buffers which comprises a base lubricating oil and (A) at least one phosphorus-containing compound selected from the group consisting of (a) a phosphoric acid ester, (b) a phosphorous acid ester, and (c) a salt of the phosphoric acid ester (a) and/or the phosphorous acid ester (b) an aliphatic monoamine having 8-22 carbon atoms; and (B) at least one nitrogen-containing compound selected from an aliphatic polyamine and a salt thereof with an aliphatic acid. See column 2, lines 5-50 in '423 and column 2, line 13 to col.3, top, in '104. The base lubricating oil includes both mineral oil and synthetic oil and preferably has a viscosity in the range of 8-60 cSt at 40°C. Both references teach the addition of other additives to the composition including ashless dispersants such as succinic imide, succinic esters and benzyl amine. See column 13, lines 9-32, and claim 20 of '423 and see column 6, lines 4-5 of '104. The examiner maintains the position that the Miyagawa references clearly meet the limitations of the above rejected claims when component (A) is (c) a salt of phosphoric acid ester

(a) and a salt of phosphorous acid ester (b) and an aliphatic monoamine having 8-22 carbon atoms. Applicants' open-ended claim language "comprising" allows for the addition of other additives to the composition such as component (B), at least one nitrogen-containing compound.

Applicants argue that "As is apparent from the above-proposed amendments, the phosphoric acid ester and thiophosphoric acid ester have been restricted in the present invention to at least one trialkylphenyl phosphate, triphenyl thiophosphate or tricresyl thiophosphate, all of which have no free hydroxyl group". Applicants continue to argue that "The preferred phosphoric acid esters and phosphorous acid esters disclosed in the Miyagawa references contain at least one hydroxyl group" ... and "since there is nothing in the Miyagawa et al references that teaches or suggests that the use of the phosphoric acid esters having no free hydroxyl group when employed in a lubricating oil composition provides satisfactory thermal stability, withdrawal of the rejection... is respectfully requested". This is not deemed to be persuasive since the Miyagawa references teach that the phosphorous-containing compounds include phosphoric acid esters containing alkylaryl and arylalkyl groups each having 6-22 carbon atoms on all three R substituents. See column 3, lines 37-49. Thus, these compounds do not contain at least one hydroxyl group. Miyagawa teaches that suitable aryl groups include phenyl and naphthyl groups, and that suitable alkylaryl groups include tolyl groups, ethylphenyl groups, etc. See column 5, lines 17-20 of ('423). Although Miyagawa appears to prefer phosphorous-containing compounds containing hydroxyl groups (R=hydrogen), the disclosure of the prior art is not limited to the preferred compounds. The examiner maintains the position that the alkylaryl

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substituted phosphorous compounds disclosed in the prior art clearly meet the limitations of the claimed compounds.

The rejection of claims 1-36 under 35 USC 103 over Okada et al (4,634,543) made in the previous office action is withdrawn in view of the amendments to the claims. The Declaration under Rule 132 filed 5 November 2004 has been fully considered but does not overcome the rejection of the Miyagawa et al references.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

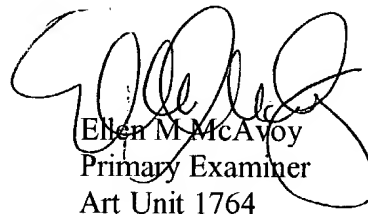
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ellen M. McAvoy  
Primary Examiner  
Art Unit 1764

EMcAvoy  
December 3, 2004